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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,900	06/26/2001	Kenneth W. Rake	IFLOW.2CP2F3C1	2814
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KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614				
			EXAMINER REICHLE, KARIN M	
			ART UNIT 3761	PAPER NUMBER

DATE MAILED: 10/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/892,900

Applicant(s)

RAKE ET AL.

Examiner

Karin M. Reichle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 14-27 is/are pending in the application.
- 4a) Of the above claim(s) 18, 20-22 and 25-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-17, 19, 23 and 24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## **DETAILED ACTION**

### ***Specification***

1. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

#### For example:

2. The amendments to the title, the abstract and page 16, line 30 do not comply with 37 CFR 1.121. The Examiner has made the necessary changes in red ink to these amendments to bring them into compliance with 37 CFR 1.121. The amendment to page 2, line 31 was not entered because such did not comply with 37 CFR 1.121, i.e. the deleted matter shown struck through and the added matter shown underlined.

### ***Priority***

3. The benefit claim filed on 8-1-03 was not entered because the required reference was not filed during the pendency of the application and prior to the later of four months from the filing date of the application or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2) and (a)(5). If applicant desires priority under 35 U.S.C. 120 based upon a previously filed copending application, applicant must file a petition for an unintentionally delayed benefit claim under 37 CFR 1.78(a)(3) or (a)(6). The petition must be accompanied by: (1) a surcharge under 37 CFR 1.17(t); and (2) a statement that the entire delay between the date

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the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional. The petition should be directed to the Office of Petitions, Box DAC, Assistant Commissioner for Patents, Washington, DC 20231.

The Office of Patent Legal Affairs was consulted and the fee of \$1330 must accompany any petition. There is no small entity discount available.

4. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

This application is claiming the benefit of a prior filed nonprovisional application under 35 U.S.C. 120, 121, or 365(c). Copendency between the current application and the prior application is required.

Copendency between the parent application 08/876,180, filed 6-23-97, and the grandparent application 07/898,958, abandoned 2-06-95, and thereby any application in the line before that application, i.e. the greatgrandparent application 07/824,855, does not exist. Therefore the oldest effective filing date of the instant application is that of 08/876,180 or 6-23-97.

5. This application appears to be a division of Application No. 08/876,180, filed 6-23-97, rather than a continuation since the invention in the parent case was a flexible, compressible medication container and the invention in this application is an infusion pump. A later application for a distinct or independent invention, carved out of a pending application and

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disclosing and claiming only subject matter disclosed in an earlier or parent application is known as a divisional application or "division." The divisional application should set forth only that portion of the earlier disclosure which is germane to the invention as claimed in the divisional application.

### ***Drawings***

6. The corrected or substitute drawings were received on 8-1-03. These drawings are approved by the Examiner.
7. It is noted that the Figures filed 8-1-03 were not labeled as replacement drawings nor were the changes to the drawings set forth in a separate section on a separate page as now required.

### ***Description***

8. The disclosure is objected to because of the following informalities: 1) The Summary of the Invention section, i.e. a description of the claimed invention, and the invention of the claims should be commensurate, see MPEP 608.01(d) and 1302.01. 2) What is line 47-47 in Figure? 3) What is 550 in Figure 65? Appropriate correction is required.

### ***Claim Rejections - 35 USC §102***

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9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. Claims 14-17, 19 and 23-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Rake et al, '716.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

See elements 12, 16, 24, 40, 42, 17, 18, 14, 13, 19 in Figures 1-4 and claims, especially last section of claims 1, 3 and 4, of Rake et al.

11. Claims 14-17, 19 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Bessesen.

See Figure 1, 1 and 3 are threadably engaged shells of generally circular outer shape, platen is 7 with nonplanar surface 9 which is complementary to inner surface of shell 1 adjacent 2, 14 is a spring fastened to shell 3. With regard to the language of lines 1, 6-7, i.e. "said space...therein", and last three lines of claim 1, similar language in claim 19 and 23 and line 1 of claim 23, such language recites function, properties or capabilities of the structure recited in the claim. Since the Bessesen patent also includes such claimed structure, such properties, functions

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and capabilities are also presumed inherent in the same structure of Bessesen. See MPEP 2112.01.

***Claim Rejections - 35 USC § 103***

12. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

13. Claims 14-15, 17, 19 and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over May '123 in view of Dorman et al '263 and Jassawalla et al '018 .

In regard to claims 14-15, 19 and 23-24, the May device, see, e.g., Figures 1-2, col. 4, lines 4-6, and col. 3, lines 56-60, includes a first shell 24, a second shell 11, a platen 15, a space 12 holding a fluid delivery bag 68 connected to an outlet tube 74 and springs 16 attached to both the platen and second shell. Also note col. 2, lines 7-10, col. 6, lines 34-41, col. 7, lines 58-65 and col. 8, lines 42-57. The May pump includes all the claimed structure and function except for the first shell having a nonplanar interior surface and the platen defining a surface complementary thereto. However, see the pump of Dorman et al at Figure 6 and col. 7, line 60- col. 8, line 2, and the pump of Jassawalla et al at Figure 2 and col. 4, lines 40-47. To make include complementary nonplanar surfaces on the first shell and platen of the May pump as taught by Dorman and Jassawalla et al would be obvious to one of ordinary skill in the art in view of the recognition that such, at the very least, would promote more complete expelling of the medical fluids in the bag of May which is cost efficient and the desire of May to cost

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efficiently expel fluids. In regard to claim 17, while the May reference does not clearly state that the shells are generally circular in outer shape, see Figures and col. 4, lines 57-63. Therefore, even if the May reference is not already expressly circular in outer shape, it certainly suggests to one of ordinary skill in the art that could be the case. Therefore to make the pump shell components of generally circular outer shape, if not already, would be obvious to one of ordinary skill in the art in view of the recognition that such would be more securely attachable to an annular ring and the desire of May for the shell components to have such capability.

### ***Double Patenting***

14. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321<sup>®</sup> may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).



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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

15. Claims 14-17, 19 and 23-24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 5,911,716. Although the conflicting claims are not identical, they are not patentably distinct from each other because since the instant application was filed later than the patent, the one way In re Vogel test applies, i.e. are the claims of the application obvious in view of the patent claims? In regard to claims 14-15, 19 and 23-24, these claims are generic or broader than the claims in the patent. Note the species of Figures 1-4 in the instant application and the patent, the election requirement of Paper No. 6 in the instant application, especially the listing of generic claims and Applicant's response in Paper No. 7 agreeing that such claims are generic to Figures 1-4. The claims in the patent are for a species or more specific embodiment. Once Applicants have received a patent for a species or more specific embodiment, they are not entitled to a patent for the generic or broader invention because the more specific "anticipates" the broader, see In re Goodman, supra. The patented claims anticipate the application claims. In regard to claim 17, see, e.g., claim 1, line 8 and col.5, line 50-51 of the patent. Therefore, in regard to claims 16 and 17, the rationale with regard to claims 14-15, 19 and 23-24 also applies.

***Response to Arguments***

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16. Applicant's remarks with regard to matters of form on pages 11, line-page 14, line 22 have been noted but are either deemed moot in that the issue has not been reraised or are deemed nonpersuasive, e.g., claims 20-22 and 25-27 remain withdrawn in light of the claim language and page 47, lines 21-30 of the specification, the priority claim can not be entered for the reasons discussed supra. Applicant's remarks with regard to the 102 rejection on pages 14-15 have been noted but are deemed nonpersuasive at this time, see discussion of priority supra. Applicant's remarks on pages 15-16 with regard to Bessesen have been considered but are deemed nonpersuasive because such arguments are narrower the claim language. Specifically, Applicant's have not specifically defined the word "complementary" and thereby the usual or common definition thereof applies, i.e. "forming or serving as a complement, completing". The surfaces of Bessesen while not identical or substantially identical in shape, as Applicant infers the term "complementary" to mean, do complete or complete each other. Furthermore, see claim 14, line 4, i.e. "platen" is a not a plate like member, i.e. "plate" as defined by the dictionary is "a smooth, flat, relatively thin, rigid body of uniform thickness, because such is claimed as having a non-planar surface, i.e. not flat. Applicant's remarks on pages 16-18 have been considered but are deemed nonpersuasive because the prior art rejection supra. It is noted that the arguments on page 16, lines 5-10 and those on page 17, last paragraph, 3-8. Applicant's remarks on page 18 with respect to the double patenting rejection have been considered but are deemed nonpersuasive because the claim to priority only affects the type of test, i.e. one-way or two-way,

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applied to determine double patenting. A double patenting rejection may be made using a priority application. The crux of the issue is what the invention of the claims is not priority.

***Conclusion***

17. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to K. M. Reichle whose telephone number is 703-308-2617. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo, can be reached on (703) 3081957. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

*K.M. Reichle*  
**KARIN REICHEL**  
**PATENT EXAMINER**

KMR

October 17, 2003